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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,622	04/27/2000	Rajesh Ranganathan	01997/521002	1966
21559	7590	11/19/2003		
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			EXAMINER WOITACH, JOSEPH T	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/559,622

Applicant(s)

RANGANATHAN ET AL.

Examiner

Joseph T. Weitach

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 25 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: 24,25,30 and 31.

Claim(s) rejected: 9,11,20-23,27,28,32 and 33.

Claim(s) withdrawn from consideration: 1-8,10 and 12-19.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


DEBORAH J. REYNOLDS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 2. NOTE: The amendment to the claims to encompass new specific hybridization conditions requires a new search and further consideration. Specifically, the recitation of "in about 50% formamide" has not been presented or considered previously. Additionally, newly added claims would have to be considered for double patenting over existing claims, for example it would have to be considered whether 'providing' a cell (new claim 34) implicitly requires 'contacting' a cell (claim 9) and thus not change the scope of the claimed method.

Continuation of 5. does NOT place the application in condition for allowance because: To the extent the arguments apply to the pending claims, Examiner would agree that the proposed amendments address the issues raised in the previous advisory action, however they do not address the basis of the rejection made under 35 USC 112, first paragraph. The present claims provide no structural limitation (no do the proposed claims) which differentiates it from the fact pattern examined in Ex parte Maizel. The ability of a polynucleotide to hybridize is a functional limitation for isolating a given polynucleotide. Even if one were to find evidence that particular hybridization conditions result in polynucleotides of a given percent identity, the specification fails to teach or describe what particular sequences among all those that would hybridize that meet any functional limitation of being functional/usable in any given assay. The amendments to the claims have not obviated the basis of the rejection, and arguments are not found persuasive for the reasons above and of record.